

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

WINTER

Mailed: January 28, 2008

Opposition No. 91177156

H-D Michigan, Inc.

v.

Bryan Broehm

JYLL S. TAYLOR, ADMINISTRATIVE TRADEMARK JUDGE:

On Thursday, January 24, 2008, the Board contacted opposer and applicant to schedule a telephone conference regarding opposer's motion (filed November 21, 2007) to extend the discovery period. The conference was scheduled for Monday, January 28, 2008, at 11:00 a.m. EST and the Board initiated the conference call.

The telephone conference was held between Linda McLeod, counsel for opposer; Bryan Broehm, applicant; and Elizabeth Winter, the Board Interlocutory Attorney assigned to this matter. Also present was Jyll S. Taylor, Administrative Trademark Judge.

The Board addressed two preliminary matters before discussing opposer's motion to extend. First, the Board advised applicant that its communications (both filed

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January 4, 2008) do not show that he served them on opposer's counsel as required under Trademark Rule 2.119. Apart from the lack of service, the Board also noted that, insofar as the communications were intended as a response to the motion to extend, they were untimely. See Trademark Rule 2.127(a), 37 C.F.R. § 2.127(a). Opposer objected to the Board's consideration of applicant's communications. In view thereof, applicant was advised that the Board could not consider his communications unless it found that the reasons for his failure to timely respond to the motion constituted "excusable neglect."¹ The Board stated that applicant's stated reasons for the untimely filings, *i.e.* that he "was unfamiliar with the proper manner" in which to contact the Board to oppose the request, and "due to the holidays and other circumstances, [he] was unable to follow up by contacting the TTAB by telephone until this date," (*i.e.* January 4, 2008), do not constitute excusable neglect. See *Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d 1582 (TTAB 1997), citing *Pioneer Investment Services Company v. Brunswick Associates Limited Partnership*, 507 U.S. 380 (1993). Accordingly, applicant's responses were not considered in this decision. Nonetheless, because it is clear that

¹ When an act is to be done within a specified time, the Court may "upon motion made after the expiration of the specified period permit the act to be done where the failure to act was the result of excusable neglect." Fed. R. Civ. P. 6(b).

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applicant did not concede the motion to extend, the parties were informed that the motion to extend would be decided on its merits.

In regards to the second preliminary matter, the Board inquired of opposer as to its reason for serving a notice of deposition under Fed. R. Civ. P. 30(b)(6), given that applicant is an individual. Opposer's counsel responded that the notice was issued for the purpose of attaching a schedule of intended topics. However, because applicant is not a corporate entity, the Board determined that the deposition under 30(b)(1) is sufficient and quashed the deposition noticed under Fed. R. Civ. P. 30(b)(6).² Additionally, upon the Board's query as to which additional documents opposer seeks from applicant, if any, opposer advised the Board that applicant had provided supplementary documents and opposer did not seek further discovery from applicant.

The Board thus considered opposer's motion as it pertained to whether the discovery period should be extended for thirty days for the sole purpose of scheduling and taking the previously noticed 30(b)(1) deposition of applicant. In support of its motion, opposer argues that good cause exists to extend the discovery period because it

² Notably, opposer could have attached the schedule to the 30(b)(1) notice.

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has been diligent during the discovery period, it timely served its notice of the deposition on applicant, and it has acted in good faith to provide to applicant alternative deposition dates or to accommodate applicant's availability, but was unable to reschedule the deposition before the end of the discovery period. Opposer also argues that it has not been guilty of any undue delay or negligence during the discovery period and, because the subject motion is opposer's first request for an extension of time, opposer contends that it has not abused the privilege of receiving extensions of time. Opposer further argues that applicant would not be prejudiced by the requested extension.

The standard for allowing an extension of a prescribed period prior to the expiration of that period is "good cause." See Fed. R. Civ. P. 6(b) and Trademark Trial and Appeal Board Manual of Procedure (TBMP) § 509 (2d ed. rev. 2004). The Board generally is liberal in granting extensions of time so long as the moving party has not been guilty of negligence or bad faith and the privilege of extensions is not abused. See, e.g., *American Vitamin Products Inc., v. DowBrands Inc.*, 22 USPQ2d 1313 (TTAB 1992); and *Sunkist Growers, Inc. v. Benjamin Ansehl Company*, 229 USPQ 147 (TTAB 1985).

After careful review of opposer's motion and exhibits, the Board finds that opposer has shown good cause for the

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requested extension. Specifically, there is no evidence that opposer is guilty of bad faith or negligence with respect to the prosecution of this case. Nor does the Board find that opposer has abused its privilege of extensions. Indeed, this is the first request for any extension filed by either party in this case. Finally, there is no evidence in the record to show that applicant would suffer any prejudice, other than a short delay, if the requested extension were granted.

In view of the foregoing, opposer's motion to extend is **granted** for the sole purpose of the taking of the previously noticed deposition of applicant pursuant to Fed. R. Civ. P. 30(b)(1).

Accordingly, opposer is allowed until **THIRTY DAYS** from the mailing date of this order to schedule and take the deposition of applicant. No additional discovery is allowed.

When asked whether the parties had dates available within the next thirty days for conducting the deposition, opposer's counsel stated that it would need to confer with opposer as to available dates. The Board advised the parties that it expected them to cooperate with one another and to conduct the deposition within thirty days of this order.

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As a general matter, the parties are reminded that they are expected to cooperate with one another in the discovery process, and the Board looks with extreme disfavor upon those who do not. Each party or its attorney (or other authorized representative) has a duty not only to make a good faith effort to satisfy the discovery needs of its adversary, but also to make a good faith effort to seek only such discovery as is proper and relevant to the issues in this case. See TBMP § 402.01 (2d ed. rev. 2004).

The Board also advised applicant that strict compliance with the Trademark Rules of Practice and, where applicable, the Federal Rules of Civil Procedure, is expected of him, even though he is not represented by counsel. The Board specifically advised applicant to use a certificate of service, more fully discussed *infra*, to show proof of service on opposer of submissions filed with the Board and recommended use of the Board's electronic filing systems (ESTTA).³

Applicant is further advised that an *inter partes* proceeding before the Board is similar to a civil action in a Federal district court. However, the Board does not preside at the taking of testimony. Rather, all testimony is taken out of the presence of the Board during the assigned testimony period, and the written transcripts thereof, together with any exhibits thereto, are then filed with the Board. **No paper,**

³ Electronic filings may be made at <http://estta.uspto.gov/>.

document, or exhibit will be considered as evidence in the case unless it has been introduced in evidence in accordance with the applicable rules.

As discussed during the telephone conference, applicant's filings with the Board did not indicate proof of service of a copy of the documents on counsel for opposer as required by Trademark Rule 2.119. Trademark Rules 2.119(a) and (b) require that every paper filed in the Patent and Trademark Office in a proceeding before the Board must be served upon the attorney for the other party, or on the party if there is no attorney, and proof of such service must be made before the paper will be considered by the Board. Consequently, copies of all papers which applicant may subsequently file in this proceeding must be accompanied by a signed statement indicating the date and manner in which such service was made. **Strict compliance with Trademark Rule 2.119 is required in all further papers filed with the Board.**

The Board will accept, as *prima facie* proof that a party filing a paper in a Board *inter partes* proceeding has served a copy of the paper upon every other party to the proceeding, a statement signed by the filing party, or by its attorney or other authorized representative, clearly stating the date and manner in which service was made. This written statement should take the form of a "certificate of service" which should read as follows:

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Last, discovery, for the sole purpose of taking the previously noticed deposition of applicant, and trial dates are reset as set forth below:

| | |
|--|--------------------------|
| DISCOVERY PERIOD TO CLOSE: | February 27, 2008 |
| Thirty-day testimony period for party in position of plaintiff to close: | May 27, 2008 |
| Thirty-day testimony period for party in position of defendant to close: | July 26, 2008 |
| Fifteen-day rebuttal testimony period to close: | September 9, 2008 |

IN EACH INSTANCE, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party **WITHIN THIRTY DAYS** after completion of the taking of testimony. See Trademark Rule 2.125, 37 C.F.R. §2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b), 37 C.F.R. §§2.125(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129, 37 C.F.R. §2.129.

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NEWS FROM THE TTAB:

The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 F.R. 42242. By this notice, various rules governing Trademark Trial and Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For further information, the parties are referred to a reprint

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of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:

<http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf>

http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to supplement or amend the standard order even after August 31, 2007, subject to Board approval. The standard protective order can be viewed using the following web address:

<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm>